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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,005	06/28/2001	Hakuo Ikegami	IKEGAMI=2	6398

7590

05/03/2002

BROWDY AND NEIMARK, P.L.L.C.
624 Ninth Street, N.W.
Washington, DC 20001-5303

EXAMINER

HELMER, GEORGIA L

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 05/03/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,005

Applicant(s)

IKEGAMI ET AL.

Examiner

Georgia Helmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Status of the Application

1. Claims 1-10 are pending.

Claim Rejections - 35 USC § 112 second paragraph

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

4. In claim 1,

- It is unclear whether the transgenic plant produced from the edible plant is itself edible.
- "edible" plant is unclear because this necessarily refers to an organism for which the plant is an edible foodstuff. For instance, some plants are edible to cattle (ruminants) and not to human. All subsequent recitations of this language are also rejected.
- "sequence" should be inserted after "DNA" for clarity.
- "selected from" is Markush language, but no Markush group is recited.
- "physiologically active proteins" is unclear, because the metes and bounds of this is not clear.
- "origin" is unclear, because origin can mean either the "source" or the "ancestry". All subsequent recitations of this language are also rejected.

In claim 3,

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- it is unclear whether "mammalian" refers only to "interferons", or to "interferons, interleukins, hematopoietic factors, and growth factors".
- The metes and bounds of "growth factors" is unclear. A listing of the growth factors would overcome this rejection.

Claim 4 does not further limit Claim one.

In claim 7, it is unclear what is meant by "protein(s)". Is this intended to be a limitation? Applicant should note that claim 1 is drawn to "proteins".

Claim 8 does not further limit claim 1.

- The meaning of "tissue(s)" is unclear. Does this mean tissue, or tissues, or both. If both meanings are intended, then the claims should be amended to recite these limitations specifically.

Claim 9 is unclear because "the transgenic plant of claim 1" is not the result of the recited method. What is the product of claim 9?

Clarification and/or correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-10 are rejected under 35 USC 102 (b) as being anticipated by Goodman, et al (US #4, 956, 282, issued September 11, 1990).

Goodman teaches

- A transgenic plant produced from an edible plant (column 4, lines 57-60),
- transforming the plant with a DNA encoding a physiologically active protein (column 10, 11-14),
- of a mammalian origin (column 3, lines 11-30, and column 7, lines 27-33).
- mammalian cytokines (column 3, line 20-30),
- mammalian interferon, (column 3, line 20-30),
- where the origin of the protein is murine (column 7, lines 27-33),
- where the plant is Solanaceous (column 4, lines 55-63),
- where the plant is in the form of tissue isolated from the whole plant body (column 4, lines 55-63, column 5, lines 51-59)),
- where the plant is in a processed form obtainable by extracting (column 5, lines 46-50).

An "edible" plant is inherently a plant edible in its raw or uncooked condition.

A plant containing trehalose appears to be an inherent property of the claimed transgenic plant, as plants, especially Brassica, are known to produce trehalose naturally (Vogel et al, J Exper. Botany. 52, 1817-1826, 2001).

Accordingly Goodman anticipates the claimed invention.

REMARKS

7. No claims are allowed.

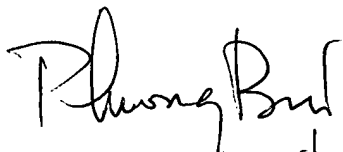
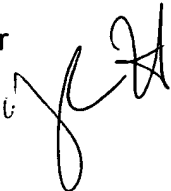
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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 703-308-7023. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia L. Helmer
Patent Examiner
Art Unit 1638
April 29, 2002



PHUONG T. BUI
PRIMARY EXAMINER 4/30/02